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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,836	05/24/2001	Hideyuki Ishikawa	SHC0127	4999

7590

12/22/2005

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EXAMINER

REICHLE, KARIN M

ART UNIT

PAPER NUMBER

3761

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/864,836	Applicant(s) ISHIKAWA, HIDEYUKI	
	Examiner Karin M. Reichle	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claim 7 is still withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on 4-9-04.

Specification

2. The substitute specification filed 10-7-05 has been entered. Applicant's statement on page 3, second and third lines from the bottom of the 10-7-05 response, are considered to be Applicant's statement that no new matter has been added.

Drawings

3. The drawings were received on 10-7-05. These drawings are accepted by the Examiner. However see the following paragraph.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as now set forth in the last section of claim 1, e.g. first zone ratio larger than second zone ratio, still must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

Art Unit: 3761

even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. Claims 1-6 and 8-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The last four lines of claim 1 as now amended claim the exact opposite of what is originally described, i.e. claims stretching toward the skin contactable surface rather than away therefrom, see the 10-7-05 substitute specification at the paragraph bridging pages 5-6 and the first sentence on page 8 as well as the Figures referred to thereby, i.e. where is the original support for the invention as is now claimed? Any traversal should include specific reference to

Art Unit: 3761

the specific page and line number where such support is presented. Also note MPEP 2163.06, I, first paragraph.

Claim Rejections - 35 USC § 102/103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3 are rejected under 36 U.S.C. 102(b) as anticipated by Divo et al, EP '714, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Divo et al, EP '714, in view of Serbiak et al, '232, and Morman et al, '760.

Claims 1-3: See Figures 1-4, 6, 9-13, col. 6, lines 31-39, i.e. portion(s) selectively "activated" while other remaining or second portion(s) remain unactivated, col. 1, lines 3-16, col. 3, lines 52-55 (it is noted "elongation as defined by the dictionary means "stretched out, lengthened), col. 8, line 6-col. 9, line 6 (Note definition of "nonwoven" in Materials Handbook provided in a previous Office Action), col. 9, line 19-col. 10, line 19, col. 11, lines 20-46, col. 12, line 20-col. 13, line 5, col. 14, lines 28-30, col. 15, line 42 -col. 16, line 4, i.e. the cover is 26, the pervious sheet is 24, the core is 28, the elastic members are 32, the first layer is 5 or 11, the second layer is 3 or 7 and 15. The portions cited supra, especially Figures 2-3, col. 3, lines 52-55, col. 11, lines 20-46, and col. 6, lines 31-39 disclose the ratio set forth on lines 11-19 of claim 1, i.e. teach the nonwoven, i.e. continuous fibers, are activated in a first zone, e.g. the continuous fibers are longer between bonding points due to gathering, and not activated in a remaining or second zone, i.e. the continuous fibers are shorter between bonding points because not gathered. It is the Examiner's first position that col. 6, lines 31-39 also teach the structure of lines 21-22 of

Art Unit: 3761

claim 1 and claim 2. Lines 19-21 and 22 et seq of claim 1 recite function or capability of the claimed structure. The Divo device includes the same structure, see cited portions above.

Therefore there is sufficient factual basis to conclude that the function or capability of the claimed structure is also inherent in the same structure of Divo. See MPEP 2112.01. In any case, the Examiner's second position, Divo, at the very least, teaches providing elasticity to a backsheet consisting of the composite elastic member wherein only parts of the composite are activated or extensible while others are not. Serbiak et al and Morman et al teach, see Figures thereof, it is known in the diaper art to provide elasticity to a backsheet consisting of a composite elastic member wherein only the transverse middle zone part is extensible while the remainder is not. Such structure is for the purposes of better fit and comfort, see abstract of Morman and col. 12, lines 31-32 of Serbiak et al. It is also noted that Serbiak et al also teaches such can be combined with elastic members or not, see col. 12, line 26-28 thereof. Therefore to make the part of the composite which is activated or extensible only the transverse middle portion of the backsheet as taught by Serbiak et al and Morman et al on the Divo et al device would be obvious to one of ordinary skill in the art in view of the recognition that such would provide a backsheet where only a portion is activated while the remainder is not as desired by Divo et al.

Furthermore, such a feature would provide good fit as well as comfort and good fit is desirable in any diaper because otherwise it does not contain fluid. Lines 19-21 and 22 et seq of claim 1 recite function or capability of the claimed structure. The prior art combination teaches the same structure, see cited portions above. Therefore, there is clear and convincing evidence that the claim's functional or characteristic recitation necessarily flows and/or is inevitably present in the teachings of the prior art of record.

Claim Rejections - 35 USC § 103

8. Claims 4 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Divo alone or Divo, Serbiak and Morman in view of Estey et al.

Applicant claims the elastic layer being formed of nonwoven material made of crimped fibers and the second layer made of polypropylene or propylene copolymers. Divo et al only disclose the elastic layer as being elastic films or nonwovens, see col. 8, lines 16-18 and col. 10, line 16 and the second layer being nonwovens of polyethylene, see col. 8, lines 13-15 and col. 10, lines 5-7, respectively. However, see Estey et al col. 1, lines 6-9, col. 6, lines 47-49, col. 16, lines 24-26, col. 8, lines 36-46 and col. 9, lines 22-26, i.e. in the diaper art, in elastic composites, the interchangeability of elastic films and nonwovens of noncrimped fibers with elastic nonwoven webs of crimped fibers and the interchangeability of polyethylene nonwoven nonelastic for polypropylene or propylene copolymer nonelastic nonwovens. To make the elastic film or nonwoven of noncrimped fibers of Divo et al a nonwoven material made of crimped fibers instead and to make the second layer of Divo et al as claimed instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Estey et al.

9. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Divo, Serbiak and Morman.

Applicant claims the elastic layer being formed of a liquid impervious sheet which lies inside the second layer. Divo et al only discloses such elastic layer as being elastic films or nonwovens and coextensive with the second layer initially and the desire that the backsheet be liquid impervious and have a clothlike appearance, see cited portions supra. However, see Serbiak et al at Figure 2, col. 6, lines 44 et seq, col. 7, lines 18-20 and col. 2, lines 42-47, i.e. in

Art Unit: 3761

the diaper art, in elastic composites, the interchangeability of elastic pervious films and elastic impervious films. To make the elastic film of Divo et al a fluid impervious elastic film instead would be obvious to one of ordinary skill in the art in view of the interchangeability as taught by Serbiak et al. It would also provide the imperviousness of the backsheet as desired by Divo et al. Additionally to make the elastic layer the innermost of the two layers as taught by Serbiak et al on the Divo et al device would be obvious to one of ordinary skill in the art as providing a more clothlike appearance as desired by Divo et al. The last two lines of claim 6 recite function or capability of the claimed structure. The prior art combination teaches the same structure, see cited portions above. Therefore, there is clear and convincing evidence that the claim's functional or characteristic recitation necessarily flows and/or is inevitably present in the teachings of the prior art of record.

Response to Arguments

10. Applicant's remarks in the various responses have been noted but are either deemed moot in that the issue discussed has not been repeated or deemed not persuasive in that the argument is narrower than the claim language, e.g. the claim language argued on page 12, lines 6-22 of the 10-7-05 response is not consistent with that of claim 1 as now amended, and the teachings of the art, e.g. contrary to Applicant's argument at page 14, first sentence of the 10-7-05 response, Serbiak can include elastic in the side portions, see, e.g., col. 9, lines 18-19 and note "need not" means may or may not.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any new grounds of rejection were necessitated by the amendments to claim 1.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
December 19, 2005